

## IN THE UNITED STATES PATENT OFFICE

Patent Application Serial No. 09/578,631	)	Group No.: 3627
	)	
Filed: May 25, 2000	)	Examiner: F. Bartuska
	)	
Title: DISK DISPENSING AND RETRIEVAL SYSTEM	)	Attorney Docket: 387953
AND ASSOCIATED METHODS [as amended]	)	
	)	
Inventors: William H. Barber et al.	)	

**DECLARATION OF WILLIAM H. BARBER  
AND PHILIP J. TOMASI  
IN ACCORDANCE WITH 37 CFR §1.131**

We, William H. Barber and Philip J. Tomasi, hereby declare:

1. We are named inventors in U.S. Patent Application No. 09/578,631 (the '631 Application), filed on May 25, 2000.
2. William H. Barber currently resides at 1845 Brush Oak Court, Thousand Oaks, CA 91320; William H. Barber has obtained the following university degrees: B.A. (UCSB, 1987), M.B.A. (CU, 1998).
3. Philip J. Tomasi currently resides at 1115 Del Verde Court, Newbury Park, CA 91320; Philip J. Tomasi has obtained the following university degrees: B.S. Civil Engineering (Cal State Chico, 1980).
4. William H. Barber is the founder and director of Freeflyr, Inc., which owns all right, title and interest in and the '631 Application.
5. Philip J. Tomasi is Chief Technical Officer of Freeflyr, Inc
6. We have studied and understood the specification and claims in the '631 Application. The claims of the '631 Application generally relate to a disk dispensing and retrieval system, and methods thereof, such as to dispense a DVD to users.
7. We have read and understood the contents of the Office Action dated May 8, 2002 for this '631 Application.
8. We have read and understood the references cited by the Examiner in the Office Action of May 8, 2002, in particular, United States Patent No. 6,182,857, issued February 6, 2001 to Hamm et al.
9. This Declaration is being presented under 37 C.F.R. §1.131 to show prior invention by virtue of conception prior to the effective filing date (December 31, 1998) of Hamm et al. and

continued due diligence from conception to an effective reduction to practice in the effective filing date of the '631 Application.

10. Attached hereto are Exhibits 1-19, which are copies from William Barber's lab notebook ("Lab Notebook") stored in a safe deposit box at Wells Fargo Bank, 140 E. Thousand Oaks Blvd Thousand Oaks, CA 91360.

11. Exhibit 1 is one page of the Lab Notebook dated June 17, 1998 and describing (a) a design for a disk dispensing and retrieval system and (b) a plan for prototyping the disk dispensing and retrieval system in 1998.

12. Exhibit 2 is one page of the Lab Notebook dated June 22, 1998 and describing meetings with lawyers at the law firms of Chrisman, Bynum & Johnson and Cooley Godward; these meetings included discussions regarding the patenting of the disk dispensing and retrieval system.

13. Exhibit 3 consists of two pages of the Lab Notebook dated June 23, 1998 and illustrating possible disk configurations for the disk dispensing and retrieval system.

14. Exhibit 4 is one page of the Lab Notebook dated June 26, 1998 and describing a telephone call with Cooley Godward and further development of the disk dispensing and retrieval system.

15. Exhibit 5 is one page of the Lab Notebook dated June 30, 1998 and describing (a) market research for the disk dispensing and retrieval system and (b) a meeting with North Communications, which was considered a possible commercialization partner.

16. Exhibit 6 consists of three pages of the Lab Notebook, dated July 2, 1998 through July 7, 1998, and describing (a) market research regarding Blockbuster video rentals, (b) further kiosk design illustrations, and (c) a confidential meeting with K.I.S. regarding engineering design for the disk dispensing and retrieval system.

17. Exhibit 7 is one page of the Lab Notebook dated July 31, 1998 and describing a conference call with Philip J. Tomasi and North Communication, regarding kiosk design particulars.

18. Exhibit 8 is one page of the Lab Notebook dated August 5, 1998 and describing a meeting with Gary Bloomer of the Boulder Technology Incubator, to assist in commercialization of the disk dispensing and retrieval system.

19. Exhibit 9 is one page of the Lab Notebook dated August 20, 1998 and describing a patent search and contact with CD equipment manufacturers.

20. Exhibit 10 consists of two pages of the Lab Notebook dated August 31, 1998 and describing a meeting with Philip J. Tomasi regarding a development plan for the disk dispensing and retrieval system; Exhibit 10 further describes purchase and installation of a DVD-ROM

drive and touch screen prototype.

21. Exhibit 11 consists of two pages of the Lab Notebook dated September 27, 1998 and October 13, 1998, respectively, which describe testing of CD and DVD transport systems.

22. Exhibit 12 is one page of the Lab Notebook dated October 30, 1998 and describing signing a lease with Boulder Technology Incubator, to assist in commercializing the disk dispensing and retrieval system.

23. Exhibit 13 is one page of the Lab Notebook dated November 2, 1998 and describing further development of the disk dispensing and retrieval system during a first residence day at the Boulder Technology Incubator.

24. Exhibit 14 is one page of the Lab Notebook dated November 5, 1998 and describing a meeting with the Chrisman, Bynum and Johnson law firm regarding forming a business entity to commercialize the disk dispensing and retrieval system.

25. Exhibit 15 consists of three pages of the Lab Notebook dated November 19, 1998, November 20, 1998, and November 23, 1998, respectively, and describing design particulars for the disk dispensing and retrieval system.

26. Exhibit 16 consists of two pages of the Lab Notebook dated December 7, 1998 and December 8, 1998, respectively, and describing meetings with potential lawyers and advisory board members to assist in commercializing the disk dispensing and retrieval system.

27. Exhibit 17 is one page of the Lab Notebook dated December 16, 1998 and describing further design issues for the disk dispensing and retrieval system.

28. Exhibit 18 consists of two pages of the Lab Notebook dated January 5, 1999 and January 6, 1999 (these pages incorrectly recite 1998), respectively, and describing further DVD kiosk development and meetings with lawyers to discuss forming an LLC to commercialize the disk dispensing and retrieval system; this LLC was formed January 15, 1999 as Freeflyr, LLC, which merged into Freeflyr, Inc. August 16, 2000.

29. Exhibit 19 is one page of the Lab Notebook setting forth press release collateral of the disk dispensing and retrieval system for use in public meetings after May 25, 1999; the press release was prepared during a period of January 1, 1999 and May 25, 1999.

30. From the fall of 1998 to May of 1999, materials for filing of a patent application for the disk dispensing and retrieval system were prepared; that patent application was filed on May 25, 1999 as U.S. Application Serial No. 60/135,854 (the '854 Application) and included mechanical drawings for DVD transfer mechanisms, a prototype electronic layout and system architecture.

31. From May of 1999 to July of 1999, materials for filing of a patent application for the disk dispensing and retrieval system we prepared; that patent application was filed on July 13, 1999 as U.S. Application Serial No. 60/143,601 (the '601 Application) and included mechanical

drawings for DVD transfer mechanisms and source code.

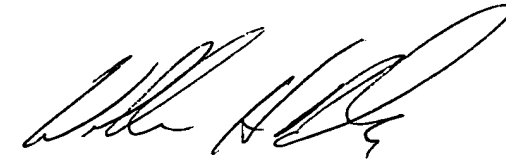
32. The present '631 Application incorporates disclosure from, and claims priority to, the '854 Application and the '601 Application.

33. We conceived and, with due diligence, pursued an effective reduction to practice of the disk dispensing and retrieval system entirely within the United States.

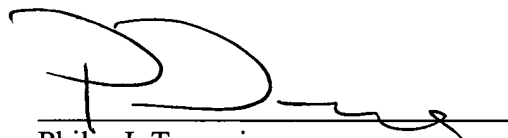
We hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the Application or any patent issued thereon.

Respectfully submitted,

Dated 5/20/2003

  
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William H. Barber

Dated 5/20/2003

  
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Philip J. Tomasi